

Remarks

Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayakawa et al. (US 5,550,938). Claims
5 2-3 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayakawa et al. in view of Shih (US 6,504,626).

1. Rejection of claims 1, 4, and 5 under 35 U.S.C. 102(b):
10 Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayakawa et al. (US 5,550,938) for reasons of record, as recited on page 3 of the above-indicated Office action (part of paper no.12).

15 **Response:**

The Applicant has carefully considered the Examiner's "Response to Arguments", and respectfully disagrees with the Examiner's analysis of the Hayakawa patent as it relates to
20 claim 1 of the instant applicant.

The Examiner states "that in Col.4, lines 46-49 Hayakawa teaches of the option of data being transmitted without the host. If the switch is not
25 pressed within a predetermined period of time, the image scanner transmits the previous drawing. The image data can be displayed and reviewed to select whether to store a particular scanned image and whether to transfer a stored image."

30

However, upon reviewing Col.4, lines 39-54, the switches 3c(1) to 3c(4) are only used to select an

image within the scanner to send to the host computer. The switch 3c(4) can be used to transmit the images from a reading buffer 62 to an SRAM 5. However, the SRAM 5 is not an external portable storage device, and is merely a memory within the scanner. Hayakawa states "If the switch 3c(4) is not pressed with a predetermined time, the image scanner returns to the main loop 902 and displays the image data corresponding to the first drawing 903" (col4, lines 45-48). However, after the predetermined time has elapsed, the image scanner does not transmit an image. The image scanner only displays another image.

In addition, the switch 3c(3) can be used to transmit the images from the reading buffer 62 to the host computer 21. Yet, the host computer 21 is not an external portable storage device, and Hayakawa's teaching is contrary to the final limitation of claim 1 that states, "...transmits the image data converted by the control unit to the storage device without the need of a host to control image data transmission." The host computer 21 taught by Hayakawa would act as a host, or master device, while treating the image scanner 1 as a slave device.

The Examiner goes on to say that the system of Hayakawa is controlled by the external disc driver 22. However, the disc driver 22 is still controlled by the personal computer 21, so the image scanner 1 is still using the personal computer 21 as a host.

The image scanner 1 can be inserted into the card insertion portion 22a of the disc driver 22 of the personal computer 21, or can be inserted into a card
5 insertion portion 23a of a word processor 23. Nevertheless, both the personal computer 21 and the word processor 23 act as a host to the image scanner 1 (col.3, lines 43-55; col.4, lines 1-7).

10 In the instant application, the control program 28 completely controls the transmission of data from the scanner 10 to the storage device 21, all without the need of a host device. This is stated in the specification on page 5, lines 27-32: "When
15 the scanning module 14 finishes scanning the document 13, the control program 28 identifies the device connected to the output port 18 and then controls the transmission of the image data 30 of the document 13 from the memory 26 to the storage
20 device 21 or to the printer 20 via the output port 18. Hence, the image data 30 need not be processed by the computer 24." The specification is also summarized on page 7, lines 3-4 by repeating that "Hence, no host computer is required to perform
25 printing or storing of scanning data." In other words, the scanner 10 acts as a host device and the storage device 21 acts as a slave device for receiving image data 30 from the scanner 10.

30 Hayakawa, on the other hand, teaches a scanner that needs to be connected to a host, such as a personal computer or a word processor, in order to

transfer image data from the scanner to a storage device. The scanner can be used alone to scan images, but must be linked to a host when data is desired to be transferred. The scanner does not operate as
5 a host when transferring images, but rather acts as a slave device to the personal computer or word processor that serve as a host (col.3, lines 43-55; col.4, lines 1-7).

10 Shih (US 6,504,626) teaches an electronic device 64 connected to a scanner 40 for receiving image signals from the scanner 40. However, Shih never teaches or suggests that the electronic device 64,
15 is an external portable storage device as is specified in claim 1. In Col.3, lines 10-25, Shih teaches that the electronic device 64 can be a internet server, LAN server, printer, personal computer, or fax machine. However, none of these
20 devices qualify as external portable storage devices. This is again contrary to the limitations of claim 1.

Therefore, neither Hayakawa nor Shih teach a scanner that directly transmits image data to an
25 external portable storage device without the need of a host to control image data transmission. Claims 4 and 5 are dependent on claim 1 and should be allowed if claim 1 is allowed. Reconsideration of claims 1, 4, and 5 is respectfully requested.

30
2. Rejection of claims 2-3 and 6-8 under 35 U.S.C. 103(a):
Claims 2-3 and 6-8 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Hayakawa et al. in view of Shih (US 6,504,626) for reasons of record, as recited on pages 4-6 of the above-indicated Office action (part of paper no.12).

5

Response:

As stated above, Shih does not teach or suggest a scanner that directly transmits image data to an external portable storage device.

10

Since neither Hayakawa nor Shih teach directly transmitting image data to an external portable storage device without the need of a host to control image data transmission, claim 6 cannot be unpatentable over Hayakawa et al. in view of Shih. Moreover, claims 2-3 and 7-8 are dependent on their respective base claims and should be allowed if the respective base claims are allowed. Reconsideration of claims 2-3 and 6-8 is hereby requested.

20

3. Missing figures in the Hayakawa (US 5,550,938) patent:

While reviewing the Final Office Action dated 12/17/2003, the Applicant discovered that no copy of Fig.8 and Figs.9b-9d were received from the USPTO with the mailing of the first Office Action dated 08/13/2003. The Applicant then tried finding the missing figures on the USPTO website, but the figures were also missing from the online publication of the Hayakawa (US 5,550,938) patent. The remarks made above are all made to the best of the Applicant's ability based on the available figures and the specification. The Applicant also

25

30

requests that the Examiner provide the Applicant with a copy of Fig.8 and Figs.9b-9d during the next communication from the Office.

5

Respectfully submitted,

10



Date:



Winston Hsu, Patent Agent No.41,526

P.O. BOX 506

15 Merrifield, VA 22116

U.S.A.

e-mail: winstonhsu@naipo.com.tw

(Please contact me by e-mail if you need a telephone communication and I will return your call promptly.)